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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/673,159	09/30/2003	Tsuneco Ohno	107391-00000	9822

7590 06/02/2005

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EXAMINER

BEHNCKE, CHRISTINE M

ART UNIT	PAPER NUMBER
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3661

DATE MAILED: 06/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/673,159

Applicant(s)

OHNO ET AL.

Examiner

Christine M. Behncke

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 5/19/2005 & 9/30/05
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. This office action is in response to the application filed 30 September 2003, in which claims 1-8 were presented for examination.

Double Patenting

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994; a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. **Claim 1** is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of copending Application No. 10/673160. Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 1 of issue is broader and anticipates the claim of the copending application. Specifically, claim 1 of issue contains all of the limitations except: "wherein said second execution module executes said second computer program by using transferred data of said data which are transferred data of said data which are transferred from said second recording device to said first recording device" of claim 1 of the copending application. However, this limitation does

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not change the scope of the claim since the claim already states the second execution module executes the second computer program, which stores the original data that is transferred to the first recording device, concurrently with the operation of the installation module.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

4. **Claim 8** is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 11 of copending Application No. 10/679285. Although the conflicting claims are not identical, they are not patentably distinct from each other because although the claims are not worded exactly the scope of the claim is identical. The copending application claim describes a method for upgrading a vehicle navigation system including an optical disk drive which stores a new navigation software set and a hard disk that stores an old navigation software set; determining if an optical disk is available in the disk drive; carrying out the old navigation software when the optical disk is not available; carrying out the new navigation software when the optical disk is available; and installing the new navigation software from the optical disk to the hard drive. The claim 1 of issue comprises a method for upgrading a vehicle navigation system but does not specify "old navigation software" or "new navigation software" but instead an "original navigation program" and an "update navigation program".

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-4 and 8 are rejected under 35 U.S.C. 102(b) as being anticipated by Nagaki, US Patent Application Publication No. 2001/0004724.

6. **(Claim 1)** Nagaki discloses a vehicle navigation system comprising: first and second recording devices (Hard disc 15 and DVD-ROM 1) storing therein first and second computer programs ([0069] and [0064]-[0065]), respectively, wherein said first and second computer programs are used for vehicle navigation; a first execution module executing said first computer program (Hard drive 15); a second execution module executing said second computer program (DVD-ROM drive 14); an install module transferring data stored in said second recording device to said first recording device (RAM 13), wherein said install module and said second execution module concurrently operate ([0102] and [0106]), and said first execution module is prohibited from operating during operation of said second execution module ([0103]).

7. **(Claim 2)** Nagaki further discloses wherein a read access time of the first recording device is shorter than that of said second recording device ([0106]).

8. **(Claim 3)** Nagaki further discloses wherein said first recording device includes a hard disk drive (hard disc 15), and said second recording device includes an optical disk drive (DVD-ROM drive 14).

9. **(Claim 4)** Nagaki further discloses wherein said optical disk drive is a DVD-ROM drive (DVD-ROM drive 14).

10. **(Claim 8)** Nagaki discloses a method for upgrading a vehicle navigation system including an optical disk drive (DVD-ROM drive 14) and a hard disk drive (hard disc 15), said method comprising: determining whether an optical disk storing an updated navigation program is mounted on said optical disk drive ([0086]-[0087], figure 5, step S1); executing an original navigation program stored in said hard disk drive when said optical disk is not mounted ([0005]-[0008], [0013] and [0031]); executing said updated navigation program stored in said optical disk drive in response to said optical disk being mounted ([0031], [0064], and [0086]-[0091]); and updating said navigation program through installing said updated navigation program into said hard disk during execution of said update navigation program ([0086]-[0095]).

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 5-7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Nagaki ('724) in view of Nagaki, Japanese patent application publication No. 2001-165671.

12. **(Claim 5)** Nagaki '724 discloses the vehicle navigation system previously discussed including an installation module that transfers units of data (RAM 13, [0067]-[0068]), but does not explicitly disclose wherein the data is of a predetermined size. However, the Japanese application teaches wherein said install module (RAM 34) transfers said data in units of data blocks, each having a predetermined data size ([0017]). It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the system of Nagaki '724 with the teachings of Nagaki's Japanese application because the predetermined partitioning of data allows for better control over the transfer operation and storage allocation.

13. **(Claim 6)** Nagaki '724 further discloses a display management module (display controller 21 and display device 20) adapted to display a data size of data to be transferred to the first recording device on a display device ([0073]).

14. **(Claim 7)** Nagaki '724 further discloses a display management module (display controller 21 and display device 20) adapted to display a necessary duration for completing transfer of a remainder of said data to said first recording device on a display device ([0073], [0091] and [0108]).

Conclusion

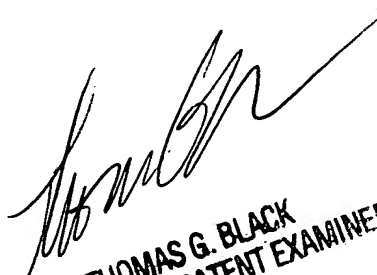
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15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christine M. Behncke whose telephone number is (571) 272-8103. The examiner can normally be reached on Monday - Friday 8:30 AM - 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas G. Black can be reached on (571) 272-6956. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

05-26-2005


THOMAS G. BLACK
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